

### **REMARKS/ARGUMENTS**

The Office Action dated August 20, 2003 has been received and its contents carefully considered. Claims 1-20 are pending. Claims 1-20 have been rejected. Claims 1, 12 and 13-17 have been amended. Claims 2-4 and 18-20 have been cancelled.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

### **CLAIM REJECTIONS – 35 U.S.C. § 112**

Claims 15 and 16 were rejected for insufficient antecedent basis as outlined in the previous Office Action. Both claims 15 and 16 have been amended and are believed to be in compliance.

### **CLAIM OBJECTIONS**

Claims 1 and 17 were objected to for insufficient antecedent basis as outlined in the previous Office Action. Both claims 1 and 17 have been amended to recite claim language as suggested by the Examiner.

### **CLAIM REJECTIONS – 35 U.S.C. § 102(b)**

Claims 1-4, 12, 14, 15 and 17-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Seashore et al. (U.S. Patent 5,916,286). Without conceding the propriety of the rejection, independent claims 1, 12 and 17 have been amended. It is respectfully submitted that Seashore et al. does not teach, *inter alia*, a diagnostic tool “wherein the location of a diagnostic

value in the list the diagnostic values is selectable by a user, the diagnostic tool further comprising an input device for selecting diagnostic values in the list wherein said input device can be used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list” as recited in claim 1 and similarly in claim 17. Furthermore, it is respectfully submitted that Seashore et al. does not teach a method of displaying diagnostic data comprising “selecting a first diagnostic value from the list of displayed values and changing a placement location of the first selected diagnostic value within an order of the list” as recited in claim 12.

Seashore et al. teaches a portable automotive diagnostic tool 30 for receiving information from an automotive computer of a vehicle. Seashore et al. discloses, for instance in column 6, lines 37-45, a group of keys on the keypad 22 for navigating keys for controlling information displayed on display 23. An UP button may scroll or move up to display data in a stream data and a DOWN button may be used to scroll or move down to display data in the stream of data. Seashore et al. further discloses that a NEXT button causes the next data in the data stream to be displayed on display 23 and a BACK button moves to display the previous data in the stream of data. Thus, the actually order of available values is not altered in the available stream data list. The diagnostic tool of Seashore et al. merely includes information values which are scrolled through, *e.g.*, in an upwardly or downwardly fashion, but the information values are not actually reordered in the placement of the list as currently recited in the independent claims of the present invention.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be

inherently present (M.P.E.P. 706.02). Since each and every claim limitation is not taught by the cited prior art, Seashore et al. cannot be said to anticipate the current invention as claimed.

Thus, withdrawal of the rejection is respectfully requested.

Claims 2-4 ultimately depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 14 and 15 ultimately depend from independent claim 12 and are patentable over the cited prior art for at least the same reasons as is claim 12.

Claims 18-20 ultimately depend from independent claim 17 and are patentable over the cited prior art for at least the same reasons as is claim 17.

#### **CLAIM REJECTIONS – 35 U.S.C. § 103(a)**

Claims 5-7, 10 and 13 were rejected under 35 U.S.C. §103(a) as being obvious over Seashore et al. in view of Borsuk (U.S. Patent 5,475,399). Claims 5-7 and 10 ultimately depend from independent claim 1. Without conceding the propriety of the rejection, independent claim 1 has been amended. As outlined above, it is respectfully submitted that Seashore et al. does not teach, *inter alia*, a diagnostic tool “wherein said output data is displayed on said graphical user interface as a list having an identification of one or more diagnostic values in the corresponding diagnostic value wherein the location of a diagnostic value in the list of diagnostic values is selected by a user, the diagnostic tool further comprises an input device for selecting diagnostic values in the list wherein said input device can be used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list” as recited in claim 1. Borsuk does not cure the deficiencies of Seashore et al., because it does not teach the aforementioned features of claim 1 of the present invention.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Since each and every element of the present invention is not taught by the prior art Seashore et al., alone or in combination with Borsuk, can not teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claim 13 is dependent upon independent claim 12. Without conceding the propriety of the rejection, independent claim 12 has been amended as outlined above. It is respectfully submitted that Seashore et al. does not teach, *inter alia*, a method of displaying diagnostic data comprising “selecting a first diagnostic value from a list of displayed values and changing a placement of the first selected diagnostic value within an order of the list” as recited in claim 12. Borsuk does not cure the deficiencies of Seashore et al., since it does not teach the aforementioned features recited in claim 12 of the present invention. Since each and every element is not taught by the prior art, Seashore et al. alone or in view of Borsuk can not be said to teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 8 and 9 were rejected under 35 U.S.C §103(a) as being obvious over Seashore et al. in view of Borsuk and in further view of Danielson et al. (U.S. Patent 5,895,906). Claims 8 and 9 are ultimately depend from independent claim 1. Without conceding the propriety of the rejection, independent claim 1 has been amended as outlined above. It is respectfully submitted

that Seashore et al. in view of Borsuk does not teach, *inter alia*, a diagnostic tool “wherein said output data is displayed on said graphical user interface as a list having an identification of one or more diagnostic values and the corresponding value wherein the location of a diagnostic value in the list of diagnostic values is selected by a user, the diagnostic tool further comprising an input device for selecting diagnostic values in the list, wherein said input device can used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list” as recited in claim 1. Danielson et al. does not cure the deficiencies of Seashore et al. in view Borsuk because it does not teach the aforementioned features recited in claim 1 of the present invention. Since each and every element is not taught by the prior art, Seashore et al., alone or in combination with Borsuk and Danielson et al., can not be said to teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claim 11 was rejected under 35 U.S.C. §103(a) as being obvious over Seashore et al. in view of Borsuk and further in view of Herrod et al. (U.S. Patent 6,405,049). Claim 11 ultimately depends from independent claim 1. Without conceding the propriety of the rejection, independent claim 1 has been amended. It is respectfully submitted that Seashore et al in view of Borsuk does not teach, *inter alia*, a diagnostic tool “wherein said output data is displayed on said graphical user interface as a list having an identification of one or more diagnostic values and the corresponding value wherein the location of a diagnostic value in the list of diagnostic values is selected by a user, the diagnostic tool further comprising an input device for selecting diagnostic values in the list, wherein said input device can used to select a diagnostic value to change a placement location of the selected diagnostic value within an order of the list” as recited in claim

1. Herrod et al. does not cure the deficiencies of Seashore et al. in view of Borsuk because it does not teach the aforementioned features as recited in claim 1 of the present invention. Since each and every element is not taught by the prior art, Seashore et al., alone or in combination with Borsuk and Herrod et al., can not be said to teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claim 16 was rejected under 35 U.S.C. §103(a) as being obvious over Seashore et al. in view of Borsuk and in further view of Gurne et al. (U.S. Patent 5,541,840). Claim 16 ultimately depends from independent claim 12. Without conceding the propriety of the rejection, independent claim 12 has been amended. It is respectfully submitted that Seashore et al. in view of Borsuk does not teach, *inter alia*, a method of displaying diagnostic data comprising “selecting a first diagnostic value from the list of displayed values and changing a placement location of the first selected diagnostic value within an order of the list” as recited in claim 12. Gurne et al. does not cure the deficiencies of Seashore et al. in view of Borsuk because it does not teach the aforementioned features of claim 12 of the present invention. Since each and every element is not taught by the prior art, Seashore et al., alone or in combination with Borsuk and Gurne et al., can not be said to teach the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

### CONCLUSION

In view of the foregoing remarks, Applicant submits that the application is now in condition for allowance. If, the Examiner believes that the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned by telephone if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not time filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

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